

### **REMARKS**

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

#### **Interview Summary**

Applicant thanks the Examiner for courtesies extended during the Examiner Interview conducted on May 5, 2010. Applicant has reviewed the Interview Summary issued on May 5, 2010, and agrees with its contents.

#### **Disposition of Claims**

Claims 1, 3-15, 18, 19, 21, 27, and 30-39 are pending in the application. Claims 1, 19, 30, and 39 are independent. The remaining claims depend, directly or indirectly, from claims, 1, 19, and 30.

#### **Rejections under 35 U.S.C. § 103**

##### **Claims 1, 3-7, 9, 10, 12, 13, 15, 18, 30, 33, 35-37, and 39**

Claims 1, 3-7, 9, 10, 12, 13, 15, 30, 33, 35-39 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent Application Publication No. US 2004/0128508 (“Wheeler”) in view of U.S. Patent No. 4,502,609 (“Christatos”), and further in view of U.S. Patent No. 7,111,318 (“Vitale”) and U.S. Patent No. 6,785,908 (“Kamiya”). To the extent this rejection applies to the pending claims, the rejection is respectfully traversed.

As previously asserted in the Response filed on October 15, 2009, the Examiner has purported to forth a *prima facie* case of obviousness for the aforementioned claims (see Office Action mailed April 15, 2009 and Office Action mailed March 3, 2010).<sup>1</sup> In response the Examiner's *prima facie* case of obviousness, the Applicants submit the following rebuttal arguments.<sup>2</sup> Rebuttal evidence may include evidence of "secondary considerations," such as "commercial success, long felt but unsolved needs, [and] failure of others." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

In the instant case, the Applicant asserts that there are secondary considerations, namely long felt but unsolved needs and failure of others, which render the pending claims non-obvious in view of the prior art.

Pursuant to MPEP §§ 716.04 and 2145, in order to establish long-felt need and failure of others, the Applicant must show evidence of the following:

- (i) "Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. [Accordingly], the need must have been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967)" MPEP § 716.04
- (ii) The long-felt need must not have been satisfied by another before the invention by applicant.

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<sup>1</sup> This statement should not be construed as an admission by the Applicant that the Examiner has established a *prima facie* case of obviousness.

<sup>2</sup> "If a *prima facie* case of obviousness is established, the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the *prima facie* case. See, e.g., *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)." MPEP § 2145

- (iii) The invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971)<sup>3</sup>.

In support of the Applicant's assertion of secondary considerations, the Applicant previously submitted three (3) 37 C.F.R. § 1.132 Declarations: (a) Declaration of Robert Shugarman ("Shugarman Declaration"), (b) Declaration of Robert V. Moel (Moel Declaration), and (c) Declaration of Terry Paul ("Paul Declaration") (collectively referred to as "Prior Declarations") on October 15, 2009. The Prior Declarations have been entered by the Examiner and reviewed by the Examiner, as such, they are part of the file wrapper for the referenced application. Further, the Applicant submits an additional 37 C.F.R. § 1.132 Declaration for James A. Wolsiffer ("Wolsiffer Declaration") for the Examiner's consideration.

Robert Shugarman, Robert V. Moel, Terry Paul and James A. Wolsiffer are individuals with extensive knowledge about the Cable Television Infrastructure as well as issues dealing with Cable Theft in the multi-dwelling unit (MDU) environment. (*see* Shugarman Declaration, items 2-4; Moel Declaration, items 2-5; Paul Declaration, items 2-4; Wolsiffer Declaration, items 2-7).

#### Requirement (i)

As described below, Applicant provides the following evidence in support of requirement (i) listed above. Applicant asserts the Declarations establish that cable theft in the MDU environment has been a problem since at least the mid-1980s (*see* Shugarman Declaration, item 11; Moel Declaration, item 12; Paul Declaration, items 3 and 11; Wolsiffer Declaration, items 15, 16).

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<sup>3</sup> There must be a nexus between the rebuttal evidence and the claimed invention, *i.e.*, objective evidence of nonobviousness must be attributable to the claimed invention. *See* MPEP § 2145.

Specifically, Cable Theft in the MDU Environment has occurred and continues to occur in at least the following manner: (a) Legacy Cable Distribution Boxes were physically compromised by unauthorized parties breaking into the Legacy Cable Distribution Boxes. The unauthorized parties subsequently connected non-customers to enable them to receive cable service from the Legacy Cable Distribution Box; (b) Legacy Cable Distribution Boxes were left open by Cable Company Contractors and Employees and unauthorized parties subsequently connected non-customers to enable them to receive cable service from the Legacy Cable Distribution Box; (c) Keyed locks used to secure the Legacy Cable Distribution Boxes are easily duplicated (or readily available) and, accordingly, available for current and former Cable Company Contractors and Employees to access Legacy Cable Distribution Boxes and subsequently connected non-customers to enable them to receive cable service from the Legacy Cable Distribution Box. *See* Shugarman Declaration, item 11; Moel Declaration, item 12; Paul Declaration, items 12; Wolsiffer Declaration, item 16.

There have been numerous prior unsuccessful attempts to solve this problem over at least the last 15 years. *See* Wolsiffer Declaration, item 14. In particular, the approach to combating cable theft in the MDU Environment has not changed or been successfully improved in at least the last 15 years; instead the cable theft in the MDU Environment persisted until Applicant's product was deployed in the MDU Environment. *See* Shugarman Declaration, items 4-12; Moel Declaration, items 6-14; Paul Declaration, items 6-13; Wolsiffer Declaration, items 15, 16, 21.

Finally, Applicant takes this opportunity to address the Examiner's assertions that "there is no evidence that if persons skilled in the art who were presumably working on the problem, know of the teachings of the above cited references, they would still be unable to solve the problem." Final Office Action, p. 3. Applicant's disagree with the Examiner's assertions.

Specifically, “evidence of secondary considerations is considered independently of what any real person knows about the prior art. These considerations are objective criteria of obviousness that help illuminate the subjective determination involved in the hypothesis used to draw the legal conclusion of obviousness based upon the first three factual inquiries delineated in Graham. Thus, to require that actual inventors in the field have the omniscience of the hypothetical person in the art is not only contrary to case law, see *Kimberly-Clark v. Johnson & Johnson*, 745 F.2d 1437, 223 USPQ 603 (Fed.Cir.1984), but eliminates a useful tool for trial judges faced with a nonobviousness determination.” (Emphasis Added) *Hodosh v. Block Drug., Co., Inc.* 786 F.2d 1136, 1144 (Fed. Cir. 1986). Thus, the Examiner’s assertion is contrary to established legal precedent and, as such, may not be used as a basis to reject the Applicant’s assertion of non-obviousness in view of secondary considerations.

In view of the above, the Applicant has satisfied requirement (i).

Requirement (ii)

As described below, Applicant provides the following evidence in support of requirement (ii) listed above. In particular, Applicant shows the long-felt need established in requirement (i) has not been satisfied by another before the invention by Applicant. The non-satisfaction of the long-felt need by another is evidenced by the continued cable theft (and revenue loss from interrupted service) in MDU environments in which the Applicant’s invention is not deployed and the demand for the Applicant’s RSS Cable Distribution Boxes to replace the previously installed Legacy Cable Distribution Boxes. See Shugarman Declaration, items 11, 13, and 15; Paul Declaration, items 11, 16, and 18; Wolsiffer Declaration, items 17, 19, and 21.

In addition, Applicant takes this opportunity to address the Examiner's assertion that the "key elements" were provided by the prior art and, thus, there is no long-felt need pursuant to *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1998). See Final Office Action, p. 3. Applicant disagrees with the Examiner's assertions.

The Examiner's reliance on the rationale of *Newell* is misplaced. In *Newell*, the court equated the "improvements" in the Ferguson patent at issue to be *de minimis* when compared with the Corcoran prior art and commented that:

The [Ferguson] invention ... rests upon exceedingly small and quite non-technical mechanical differences in a device which was old in the art. At the latest, those differences were rendered apparent in [1974] by the appearance of the [Corcoran shade material], and unsuccessful attempts to reach a solution to the problems confronting [Ferguson] made before that time became wholly irrelevant.

*Newell* at *id.* In contrast, the improvements made by the Applicant over the prior art solutions are non-trivial. In fact, the application and the Declarations support that the improvements are quite significant. Specifically, the Applicant's invention has at least the following additional capabilities over the prior art solutions: (i) providing functionality to remotely authorize access to the Cable Distribution Box; (ii) providing functionality to enable unlocking on the Cable Distribution Boxes after remote authorization has been granted; (iii) providing functionality to track access to the Cable Distribution Boxes using a work log, which may be remotely accessed; (iv) incorporating an internal locking mechanism, which removes external failure points of the locking mechanism used to secure the RSS Cable Distribution Boxes; and (iv) configuring the Cable Distribution Boxes to be solely powered using power from the coaxial cable line. See Shugarman Declaration, items 14, 16; Moel Declaration, items 16, 17; Paul Declaration, items 17, 19; Wolsiffer

Declaration, items 20, 22. The non-trivial improvements over the prior art, render the rationale set forth in *Newell* inapplicable to instant case.

In view of the above, the Applicant has satisfied requirement (ii).

Requirement (iii)

The claimed invention successfully addresses cable theft in the MDU environment as follows:

- (i) Providing a mechanism to remotely authorize access to the RSS Cable Distribution Box. This mechanism enables fine-grained control of who can access a particular RSS Cable Distribution Box including removing access to former Cable Company Employees and Contractors. (*See e.g.*, claims 1, 7, 8, 19, 21, 30, and 39)
- (ii) Providing a mechanism to enable unlocking on the RSS Cable Distribution Boxes after remote authorization has been granted. (*See e.g.*, claims 1, 19, 30, 33, and 39)
- (iii) Tracking access to the RSS Cable Distribution Boxes using a work log, which may be remotely accessed. (*See e.g.*, claims 10, 11-12, 19, 23, 24, 30, 31, and 39).

The success of the claimed invention is evidenced by the decrease in cable theft experienced by Cable Operators, which have deployed Cable Distribution Boxes embodying the claimed

invention. *See* Shugarman Declaration, items 13 and 15; Paul Declaration, items 16 and 18; Wolsiffer Declaration, item 21.

In view of the above, Applicant asserts that there are long felt but unsolved needs and failure of others, which renders the pending claims non-obvious in view of the prior art.

Based on the above, independent claims 1, 30, and 39 are patentable over Wheeler, Christatos, Vitale, and Kamiya, either alone or in combination. Additionally, claims depending from amended independent claims 1, 30, and 39 are also patentable for at least the same reasons. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 19, 21-23, and 25-26

Claims 19, 21-23, and 25-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wheeler, Christatos, and Kamiya. To the extent that this rejection applies to the amended claims, the rejection is traversed.

As discussed above with reference to independent claim 1, Applicant asserts that there are long felt but unsolved needs and failure of others, which render the pending claims non-obvious in view of the prior art. Independent claim 19 includes at least the same patentable limitations as independent claim 1 and, thus, is patentable over Wheeler, Christatos, and Kamiya for at least the same reasons as independent claims 1. Further, dependent claims 21-23 and 25-26 are patentable over Wheeler, Christatos, and Kamiya for at least the same reasons as independent claim 19. Accordingly, withdrawal of this rejection is respectfully requested.



Claim 8

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Wheeler, Christatos, Vitale, Kamiya, and U.S. Patent No. 6,472,973 ("Harold"). To the extent that this rejection applies to the amended claims, the rejection is traversed.

As discussed above with reference to independent claim 1, Applicant asserts that there are long felt but unsolved needs and failure of others, which render the pending claims non-obvious in view of the prior art. Accordingly, Wheeler, Christatos, Vitale, Kamiya, and Harold, whether considered separately or in combination, fail to render independent claim 1 obvious. Accordingly, independent claim 1 is patentable over Wheeler, Christatos, Vitale, Kamiya, and Harold. Dependent claim 8 is patentable over Wheeler, Christatos, Vitale, Kamiya, and Harold for at least the same reasons as independent claim 1. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 11, 24, 31, and 32

Claims 11, 24, 31, and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wheeler, Christatos, Vitale, Kamiya, and U.S. Patent Application Publication No. US 2002/0147982 ("Naidoo"). To the extent that this rejection applies to the amended claims, the rejection is traversed.

As discussed above with reference to independent claims 1, 19, and 30, Applicant asserts that there are long felt but unsolved needs and failure of others, which render the pending claims non-obvious in view of the prior art. Accordingly, Wheeler, Christatos, Vitale, Kamiya, and Naidoo, whether considered separately or in combination, fail to render independent claims 1, 19,

and 30 obvious. Accordingly, independent claims 1, 19, and 30 are patentable over Wheeler, Christatos, Vitale, Kamiya, and Naidoo. Dependent claims 11, 24, 31, and 32 are patentable over Wheeler, Christatos, Vitale, Kamiya, and Naidoo for at least the same reasons as the aforementioned independent claims. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 14, 27, and 34

Claims 14, 27, and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wheeler, Christatos, Vitale, Kamiya, and U.S. Patent Application Publication No. US 2004/0050930 ("Rowe"). To the extent that this rejection applies to the amended claims, the rejection is traversed.

As discussed above with reference to independent claims 1, 19, and 30, Applicant asserts that there are long felt but unsolved needs and failure of others, which render the pending claims non-obvious in view of the prior art. Accordingly, Wheeler, Christatos, Vitale, Kamiya, and Rowe, whether considered separately or in combination, fail to render independent claims 1, 19, and 30 obvious. Accordingly, independent claims 1, 19, and 30 are patentable over Wheeler, Christatos, Vitale, Kamiya, and Rowe. Dependent claims 14, 27, and 34 are patentable over Wheeler, Christatos, Vitale, Kamiya, and Rowe for at least the same reasons as the aforementioned independent claims. Accordingly, withdrawal of this rejection is respectfully requested.

**Conclusion**

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 17065/004001).

Dated: July 9, 2010

Respectfully submitted,

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Attachment: Declaration of James A. Wolsiffer